

REMARKS

The Examiner is thanked for the examination of the application. Favorable reconsideration in view of the following remarks is respectfully requested.

Claims 1-14 and 16-24 are pending. Currently, claims 14, 16-19 and 22-24 are under review, claims 1-13, 20 and 21 having been withdrawn as a result of the June 25, 2008 election of species requirement. Claims 14 and 22 are independent. Claim 24 has been amended to now depend from claim 14.

The Office Action rejects claims 14, 16, 17, 19, and 24 under 35 U.S.C. §103(a) over U.S. Patent No. 5,224,156, hereinafter *Fuller*, in view of U.S. Patent No. 7,199,906, hereinafter *Tamura*. Claims 22 - 23 have been rejected under 35 USC 103(a) as being unpatentable over *Fuller*, in view of U.S. Patent No. 5,946,386, hereinafter *Rogers*. Claim 18 has been rejected under 35 USC 103(a) as being unpatentable over *Fuller*, in view of *Tamura*, and further in view of U.S. Patent No. 6,825,955, hereinafter *Shibata*. These rejections are respectfully traversed.

In the non-limiting example disclosed in Applicant's published specification beginning at paragraph [0140], if a user of a receiver device, such as MFP 530, wants to receive faxes at a location other than MFP 530, the user notifies in advance each sender device, such as MFP 230, which is registered in the receiver device 530, of a destination to which send notifications should be sent, such as a mobile telephone 410, the user. In other words, MFP 530 notifies MFP 230 that send notifications should be sent to mobile telephone 410.

Then, if the user of the MFP 230 wants to send a fax to the MFP 530, the MFP 230 sends a send notification to the mobile telephone 410. The mobile

telephone 410 then responds to the MFP 230 with an address to which the fax should be sent.

Claim 14 corresponds to the MFP 230, although none of the claims herein are limited to the preferred disclosed embodiments. According to claim 14, a fax data transmission device comprises a first storing unit operable to store fax data and an identifier for identifying the fax data, in correspondence with each other. A second storing unit stores information showing a correspondence between an original destination of the fax data [such as MFP 530] and a send information destination [such as mobile telephone 410], the send information destination being a destination of send information. The send information includes the identifier and a notification that the fax data identified by the identifier is going to be sent.

A notifying unit sends the send information to the send information destination [such as mobile telephone 410] corresponding to the original destination [such as MFP 530] of the fax data, with reference to the information stored in the second storing unit. ***A receiving unit receives, as a reply to the send information, destination information from the send information destination [such as mobile telephone 410] specifying a destination to which the fax data should actually be sent.*** A sending unit then sends the fax data to the destination specified by the destination information that is extracted from the reply.

The Office Action alleges that the claimed receiving unit of claim 14 is taught by *Fuller* at, among other places, column 7, lines 45 - 50 and 65 - 68.

Fuller discloses a method and apparatus for causing a message to be sent in facsimile compatible form over a telephone system from a first location to a second remote location. The first memory 24 receives and stores an incoming fax message.

A second memory 26 contains programmable access codes which are assigned to individuals and allows the individuals to access and retrieve messages stored in the first memory 24. See column 4, lines 3 - 27. Once facsimile information is stored in the first memory 24, an individual is notified that a facsimile message has been received. *Fuller* discloses informing the recipient that a facsimile message has been received by having apparatus 60 call a telephone number and output a voice message, contact a pager or beeper, or call a remote facsimile machine and send a facsimile message to the recipient notifying that a facsimile message has been received. When the recipient has been notified that a facsimile message has been stored in his mailbox, the facsimile message may be retrieved by one of three ways of receiving the facsimile message:

When the recipient has been notified that a facsimile message has been stored in his mailbox, he may retrieve the facsimile message in several different ways. First, he may have the facsimile message automatically forwarded to another facsimile machine at a remote location. Second, he may call from a facsimile machine at a remote location and instruct apparatus 60 to transmit the facsimile message immediately on the same phone call. Third, he can go to apparatus 60 and request the apparatus 60 to print his facsimile message on the local facsimile machine. Column 7, line 65 through column 8, line 7.

However, none of these options involves the recipient of the send information sending, as a reply to the send information, destination information from the send information destination for specifying a destination to which the fax data should actually be sent, as set forth in claim 14 with respect to the receiving unit. Furthermore, the *Fuller* device is also not able to "...extract the destination information from the reply". Accordingly, *Fuller* does not teach or suggest the claimed receiving unit.

It is also interesting to note that, with respect to claim 22, the Examiner acknowledges that *Fuller* does not teach or suggest the claimed second receiving unit - which is similar to the receiving unit of claim 14.

The claimed notifying unit sends the send information via an Internet mail, and the claimed receiving unit extracts the destination information from a mail replying to the Internet mail. Thus, the process of receiving and extracting the destination to which the fax data should actually be sent is done by means of internet mail. The Examiner acknowledges that this is not taught by *Fuller*. Instead, the Examiner relies upon the teachings of *Tamura*. The Examiner alleges that *Tamura* "...teaches the send information via an internet mail...", citing column 4, lines 25 - 50, and Figures 1 - 2.

However, *Tamura* performs a different function than the present invention and does not cure the deficiencies of *Fuller*. Specifically, *Tamura* does not teach or suggest "wherein the notifying unit sends the send information via an Internet mail, and the receiving unit extracts the destination information from a mail replying to the Internet mail."

Tamura operates to send facsimile messages between a data terminal device 103 and a facsimile device 105. When going from the data terminal device 103 to the facsimile device 105, the facsimile image is attached to an e-mail sent from the data terminal device 103 to the internet facsimile gateway device 102. The internet facsimile gateway device 102 converts the image into facsimile data and sends it over a phone line to the facsimile device 105. However, *Tamura* does not teach or suggest a receiving unit operable to receive **as a reply to the send information**, destination information from the send information destination for specifying a

destination to which the fax data should actually be sent, and extract the destination information from the reply.

Accordingly, neither *Fuller* nor *Tamura* teaches or suggests the claimed combination that includes the claimed receiving unit.

In addition, it is difficult to understand how the Examiner intends to combine the internet system of *Tamura* with the *Fuller* system. In the event that the Examiner persists with the rejection, the Examiner is respectfully requested to more clearly explain how *Tamura* would teach the needed modifications to *Fuller*.

Therefore, *Tamura* does not overcome the deficiencies of *Fuller*. Claims 16, 17, 19, and 24 are patentable for similar reasons.

With regard to claims 22 - 23, the Examiner relies upon *Fuller* and *Rogers*. On page 2 of the Office Action, the Examiner alleges that the rejections are new. However, the rejection of claim 22 is identical to the rejection made in the prior Office Action. And, the Examiner has failed to address Applicants' comments submitted on April 28, 2011. Accordingly, the Office Action fails to comply with the requirement of MPEP § 707.07(f) to answer all traversed material.

The Examiner is respectfully requested to address Applicants' remarks submitted on April 28, 2011.

Applicant's independent claim 22 is directed to a fax data transmission system comprising, in combination with other claimed features, a fax data transmission device, an information communication device, and a portable communication device. The fax data transmission device includes a second receiving unit.

The Examiner acknowledges that *Fuller* does not teach a second receiving unit operable to receive destination information for specifying a destination to which

the fax data should actually be sent, as a reply to the send information. Applicants respectfully disagree that *Rogers* overcomes this deficiency of *Fuller*.

Rogers relates to a call center for forwarding an ***already received fax message*** to another destination. According to the present claim 22, the second receiving unit receives destination information for specifying a destination to which the fax data should be sent, as a reply to the send information which was sent to a send information destination. Thus, the principles are very different.

Furthermore, in *Fuller*, the user calls from a facsimile machine at a remote location and instructs the apparatus to transmit the facsimile message on the same phone call. Thus, *Fuller* does not even contemplate the use of mail. In addition, no further information is provided as to the meaning of instructing the apparatus to transmit the facsimile message. In addition, it is difficult to understand how the Examiner intends to combine an Internet mail system of *Rogers* with the phone call required by the user in *Fuller*.

Thus, claims 22 - 23 are distinguishable over *Fuller* and *Rogers* either alone or in combination.

The remaining claims are allowable for at least the reasons discussed above as well as for the individual features they recite. The *Shibata* reference does not overcome the deficiencies of *Fuller*, *Tamura* and *Rogers* noted above.

Prompt and favorable examination on the merits is respectfully requested.

Should any questions arise in connection with this application, or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: November 17, 2011

By: /WCRoland/
William C. Rowland
Registration No. 30888

Customer No. 21839
703 836 6620